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09/808,932	03/15/2001	Keizo Baba	2271/64396	4832

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EXAMINER

LETT, THOMAS J

ART UNIT	PAPER NUMBER
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2626

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DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,932

Applicant(s)

BABA, KEIZO

Examiner

Thomas J. Lett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-5, 15-19, 7, 8, 21, 22, 29-49, 51, 52, and 59-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Markowitz (US Patent 5,513,254 A).

Regarding claim 1, Markowitz discloses that the facsimile information transmitted by the user and the advertisement added in the interexchange carrier network 107, may be visually presented to the facsimile recipient, via a display, such as a computer screen (col 2, lines 43-47) of a fax capable personal computer 123 (see Fig. 1), which reads on an advertisement information acquiring device configured to acquire advertisement information from an advertisement server connected to said network via said network interface device;

a computer screen (col 2, line 47) of a fax capable personal computer 123 (see Fig. 1), which reads on a display device to display the advertisement information acquired from said advertisement information acquiring device; and

a fax capable personal computer 123 (see Fig. 1), which reads on a displaying control device configured to control the displaying of the advertisement information.

Regarding claim 2, Markowitz discloses that the combined facsimile transmission, which includes the facsimile information transmitted by the user and the advertisement added in the telephone network, may be visually presented to the facsimile recipient via a display, such as a computer screen (col 2, lines 42-47), which reads on displaying control device displays the advertisement information during a time period of transmitting facsimile data.

Regarding claim 3, Markowitz discloses that image storage 323 temporarily stores the facsimile information while a facsimile transmission is being processed (col 5, lines 54-56), which reads on a facsimile data storing device configured to store facsimile data; and a fax capable personal computer 123 (see Fig. 1), which reads on a displaying control device displays the advertisement information on said display device during a time period of storing the facsimile data.

Regarding claim 4, Markowitz discloses a fax capable personal computer 123 containing a CPU (see Fig. 1) wherein the image produced in response to the receipt of the facsimile transmission from fax server 111, which includes the combined facsimile information and advertisement, is then printed out or displayed for use by the recipient (col 4, line 65 – col 5, line 2), which reads on an outputting device configured to output the advertisement information; an advertisement information output instructing device configured to instruct outputting of the advertisement information displayed on said display device; and wherein said displaying control device outputs the advertisement information instructed by said advertisement information output instructing device with the outputting device.

Regarding claim 5, Markowitz discloses a fax capable personal computer 123 containing a CPU (see Fig. 1), which reads on an advertisement information facsimile transmission instructing device configured to instruct facsimile transmission of the advertisement information displayed on said display device; and wherein said displaying control device transmits by facsimile transmission the advertisement information instructed by said advertisement information facsimile transmission instructing device to a previously set address.

Regarding claim 7, Markowitz discloses The combined facsimile transmission, which includes the facsimile information transmitted by the user and the advertisement added in the telephone network, may be visually presented to the facsimile recipient (col 2, lines 42-46), which reads on a displaying control device combines the advertisement information with a communication control report.

Regarding claim 8, Markowitz discloses a facsimile transmission source modifies the user's facsimile transmission by incorporating with the user's facsimile information at least one advertisement (col 1, lines 36-38), which reads on said displaying control device combines the advertisement information with a part of transmission image data.

Claim 15 is a method claim and is rejected for the same reasoning as that of claim 1.

Claim 16 is a method claim and is rejected for the same reasoning as that of claim 2.

Claim 17 is a method claim and is rejected for the same reasoning as that of claim 3.

Claim 18 is a method claim and is rejected for the same reasoning as that of claim 4.

Claim 19 is a method claim and is rejected for the same reasoning as that of claim 5.

Claim 21 is a method claim and is rejected for the same reasoning as that of claim 7.

Claim 22 is a method claim and is rejected for the same reasoning as that of claim 8.

Regarding claim 29, Markowitz discloses a convenient way to update the advertisements that are incorporated into the facsimile transmissions of users (col 3, lines 57-59), which reads on a network connecting plural terminal devices with transmission paths and transmitting/receiving data between said plural terminal devices through said transmission paths;

databases 115 and 117 store advertisements for incorporation into facsimile transmissions by fax server 111 (col 3, lines 49-50), which reads on an advertisement server connected to said network; and

computer 123, which reads on a facsimile apparatus including; a network interface device connected to said network and capable of transmitting and receiving facsimile data therebetween; an advertisement information acquiring device configured to acquire advertisement information from said advertisement server through said network interface device; a display device for displaying the advertisement information

acquired by said advertisement information acquiring device; and a displaying control device configured to control the displaying of the advertisement information.

Regarding claim 30, Markowitz discloses a system in which a telephone network carrying a facsimile transmission transmitted by a user from a facsimile transmission source incorporates at least one advertisement (see Fig. 1), which reads on the facsimile apparatus of claim 1, wherein said network comprises at least one of an ISDN, a LAN, a WAN, and a telephone line.

Regarding claim 31, Markowitz discloses a system in which a telephone network carrying a facsimile transmission transmitted by a user from a facsimile transmission source incorporates at least one advertisement (see Fig. 1), which reads on the facsimile apparatus of claim 1, wherein said network comprises at least one of an ISDN, a LAN, a WAN, and a telephone line.

Claim 32 is a method claim and is rejected for the same reasoning as that of claim 30.

Regarding claim 33, Markowitz discloses a system in which a telephone network carrying a facsimile transmission transmitted by a user from a facsimile transmission source incorporates at least one advertisement (see Fig. 1), which reads on the facsimile apparatus of claim 1, wherein said network comprises at least one of an ISDN, a LAN, a WAN, and a telephone line.

Regarding claim 34, Markowitz discloses a system in which a telephone network carrying a facsimile transmission transmitted by a user from a facsimile transmission source incorporates at least one advertisement (see Fig. 1), which reads on the

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facsimile apparatus of claim 1, wherein said network comprises at least one of an ISDN, a LAN, a WAN, and a telephone line.

Regarding claim 35, Markowitz discloses the destination may be connected to the telephone network via a wireless link (col 7, lines 61-62). The wireless link can be an Internet connection, which reads on at least a portion of said ISDN, LAN, WAN, and telephone line is the Internet.

Claim 36 is a method claim and is rejected for the same reasoning as that of claim 35.

Regarding claim 37, Markowitz discloses the destination may be connected to the telephone network via a wireless link (col 7, lines 61-62). The wireless link can be an Internet connection, which reads on at least a portion of said ISDN, LAN, WAN, and telephone line is the Internet.

Regarding claim 38, Markowitz discloses the destination may be connected to the telephone network via a wireless link (col 7, lines 61-62). The wireless link can be an Internet connection, which reads on at least a portion of said ISDN, LAN, WAN, and telephone line is the Internet.

Regarding claim 39, Markowitz discloses the destination may be connected to the telephone network via a wireless link (col 7, lines 61-62). The wireless link can be an Internet connection, which reads on at least a portion of said ISDN, LAN, WAN, and telephone line is the Internet.

Claim 40 is a method claim and is rejected for the same reasoning as that of claim 38.



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Regarding claim 41, Markowitz discloses the destination may be connected to the telephone network via a wireless link (col 7, lines 61-62). The wireless link can be an Internet connection, which reads on at least a portion of said ISDN, LAN, WAN, and telephone line is the Internet.

Regarding claim 42, Markowitz discloses the destination may be connected to the telephone network via a wireless link (col 7, lines 61-62). The wireless link can be an Internet connection, which reads on at least a portion of said ISDN, LAN, WAN, and telephone line is the Internet.

Regarding claim 43, Markowitz discloses computer 123, which reads on a means for connecting to a network and for transmitting and receiving facsimile data therebetween;

computer 123, which reads on a means for acquiring advertisement information from an advertisement server connected to said network via said connecting means;

computer 123, which reads on a means for displaying the advertisement information acquired from said advertisement information acquiring means; and

computer 123, which reads on a means for controlling the displaying of the advertisement information.

Regarding claim 44, Markowitz discloses a convenient way to update the advertisements that are incorporated into the facsimile transmissions of users (col 3, lines 57-59), which reads on a network connecting plural terminal devices and transmitting/receiving data between said plural terminal devices;

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databases 115 and 117 store advertisements for incorporation into facsimile transmissions by fax server 111 (col 3, lines 49-50), which reads on an advertisement server connected to the network; and a facsimile apparatus including;

computer 123, which reads on means for connecting to said network and for transmitting and receiving facsimile data therebetween;

computer 123, which reads on means for acquiring advertisement information from said advertisement server through said connecting means;

computer 123, which reads on means for displaying the advertisement information acquired by said advertisement information acquiring means; and

computer 123, which reads on means for control the displaying of the advertisement information.

Claim 45 is a product claim and is rejected for the same reasoning as that of claim 1.

Claim 46 is a product claim and is rejected for the same reasoning as that of claim 2.

Claim 47 is a product claim and is rejected for the same reasoning as that of claim 3.

Claim 48 is a product claim and is rejected for the same reasoning as that of claim 4.

Claim 49 is a product claim and is rejected for the same reasoning as that of claim 5.

Claim 51 is a product claim and is rejected for the same reasoning as that of claim 7.

Claim 52 is a product claim and is rejected for the same reasoning as that of claim 8.

Claim 59 is a product claim and is rejected for the same reasoning as that of claim 30.

Claim 60 is a product claim and is rejected for the same reasoning as that of claim 38.

Claim 61 is a product claim and is rejected for the same reasoning as that of claim 35.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 6, 9, 14, 23, 28, 53, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (US Patent 5,513,254 A) in view of Goldschmitt (WO 9624213 A1).

Regarding claim 6, Markowitz does not disclose an advertisement information mail transmission instructing device configured to instruct electronic mail transmission of the advertisement information displayed on said display device; and wherein said

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displaying control device transmits by electronic mail the advertisement information instructed by said advertisement information mail transmission instructing device to a previously set address. Goldschmitt et al disclose an email/advertisement system where terminals are configured to send and receive electronic messages to other terminals/computers (p2, lines 16-20) and messages can be forwarded to other email users (p3, lines 15-16). Markowitz and Goldschmitt et al are analogous art because they are from the similar problem solving area of incorporating advertising in network communications messages. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the email feature of Goldschmitt et al to the computer of Markowitz in order to obtain email capability. The motivation for doing so would be to be able to send/receive email advertising.

Regarding claim 9, Markowitz discloses advertising may be visually presented to the facsimile recipient via a display, such as a computer screen (col 2, lines 42-47) of a fax capable personal computer 123 (see Fig. 1), which reads on an outputting device configured to output the advertisement information. Markowitz does not disclose said displaying control device outputs the advertisement information to the outputting device at preset times. Goldschmitt et al disclose providing a feature whereby an advertiser can append advertising information at a particular time of the day (p4, lines 15-16). Markowitz and Goldschmitt et al are analogous art because they are from the similar problem solving area of sending message data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the scheduling feature of Goldschmitt et al to process of Markowitz in order to obtain a routine of scheduling

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message transmission. The motivation for doing so would be to effectively communicate advertising.

Regarding claim 14, Markowitz does not disclose that an advertisement information acquiring device acquires the advertisement information from said advertisement server at preset times. Goldschmitt et al disclose providing a feature whereby an advertiser can append advertising information at a particular time of the day (p4, lines 15-16). Markowitz and Goldschmitt et al are analogous art because they are from the similar problem solving area of sending message data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the scheduling feature of Goldschmitt et al to process of Markowitz in order to obtain a routine of scheduling message transmission. The motivation for doing so would be to effectively communicate advertising.

Claim 23 is a method claim and is rejected for the same reasoning as that of claim 9.

Claim 28 is a method claim and is rejected for the same reasoning as that of claim 14.

Claim 53 is a product claim and is rejected for the same reasoning as that of claim 9.

Claim 58 is a product claim and is rejected for the same reasoning as that of claim 14.

2. Claims 10, 20, 24, 50, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (US Patent 5,513,254 A) in view of Gifford et al (US 20030123622 A1).

Regarding claim 10, Markowitz does not disclose said displaying control device transmits the advertisement information by electronic mail to a previously set address at preset times. Gifford et al disclose that a user interface allows the user to setup and configure a corresponding enhanced services account, including routing schedules for voice, fax, e-mail, and video calls and messages (para 104, lines 1-4). These e-mail messages may include promotional items which could be sent according to the routing schedule. Markowitz and Gifford et al are analogous art because they are from the similar problem solving area of sending message data to select recipients. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Gifford et al to Markowitz in order to obtain an effective and targeted distribution of message data. The motivation for doing so would be to effectively communicate advertising.

Claim 24 is a method claim and is rejected for the same reasoning as that of claim 10.

Claim 54 is a product claim and is rejected for the same reasoning as that of claim 10.

Regarding claim 20, Markowitz does not disclose transmitting by electronic mail the advertisement information in accordance with an instruction of transmitting by electronic mail the advertisement information displayed on said display device. Gifford

et al disclose that a user interface allows the user to setup and configure a corresponding enhanced services account, including routing schedules for voice, fax, e-mail, and video calls and messages (para 104, lines 1-4). These e-mail messages may include promotional items. Markowitz and Gifford et al are analogous art because they are from the similar problem solving area of sending message data to select recipients. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Gifford et al to Markowitz in order to obtain an effective and targeted distribution of message data. The motivation for doing so would be to effectively communicate advertising.

Claim 50 is a product claim and is rejected for the same reasoning as that of claim 20.

3. Claims 11, 12, 25, 26, 55, 56, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (US Patent 5,513,254 A) in view of Yamauchi et al (US Pat. 5,701,497).

Regarding claims 11 and 12, Markowitz does not disclose said displaying control device specifies a transmission destination country from a telephone number of a facsimile transmission address; and wherein said displaying control device combines the advertisement information in a language of the specified country with the part of transmission image data. Yamauchi et al disclose a translating unit for translating facsimile image data to identify the original language based upon various commands included in the facsimile protocol. There is also a case in which the telephone number of the sender is described in the facsimile protocol (col 2, lines 1-4). Markowitz and

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Yamauchi et al are analogous art because they are from the similar problem solving area of message translation. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of translation feature of Yamauchi et al to Markowitz in order to obtain a way to translate the combined message to effectively advertise a product. The motivation for doing so would be to convey a message to a user of a different language.

Claim 25 is a method claim and is rejected for the same reasoning as that of claim 11.

Claim 26 is a method claim and is rejected for the same reasoning as that of claim 12.

Claim 55 is a product claim and is rejected for the same reasoning as that of claim 12.

Claim 56 is a product claim and is rejected for the same reasoning as that of claim 12.

Claim 57 is a product claim and is rejected for the same reasoning as that of claim 11.

4. Claims 13 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (US Patent 5,513,254 A) in view of Boucher et al (US Pat 5,884,246).

Regarding claim 13, Markowitz does not disclose displaying control device specifies a transmission destination country from an electronic mail address of electronic mail transmission; and wherein said displaying control device transmits the advertisement information in a language of the specified country. Boucher et al disclose



a translation machine 136 that determines the language which the message is to be translated into (Step 230 in FIG. 3C). The translation machine 136 determines the country which is the destination of the translated message by the two letter country indicating top level domain and performs a translation into a preselected language in accordance with the top level domain (col 12, lines 10-14). Markowitz and Boucher et al are analogous art because they are from the similar problem solving area of message translation based on message information. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Boucher et al to Markowitz in order to obtain a way to translate the combined message to effectively advertise a product. The motivation for doing so would be to convey a message to a user of a different language.

Claim 27 is a method claim and is rejected for the same reasoning as that of claim 13.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, DC 20231

**or Faxed to:**

(703) 872-9314 (for Technology Center 2600 only).

**Hand-delivered** responses should be brought to:

Crystal Park II

2121 Crystal Drive

Arlington, VA

Sixth Floor (Receptionist).

TJL

(TJL)

*Kimberly Williams*

**KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER**